REMARKS

The claims in this application are claims 1-35.

The amendments to claims 1, 18 and 25 are supported, for example, at page 1, lines 10-12, page 3, lines 4-5 and 23-27, and page 11, lines 15-19. New claims 30-35 are supported at page 4, lines 1-4 and 10-13 of the original specification. No new matter is added.

Specification

The examiner invites the applicant to arrange the specification to include titles directed to (a) the field of the invention and (b) description of related art. These sections are set forth in MPEP 608.01(a) in conjunction with guidelines that illustrate the preferred layout for the specification of a utility application. Although these guidelines are suggested for the applicant's use, they are not required. Applicant therefore respectfully declines the examiner's invitation.

Rejection under 35 U.S.C. 102(a)

Claims 1, 5-7, 15-21, 24 and 25 have been rejected under 35 U.S.C. 102(a) as being anticipated by Brown US 6,123,681. This rejection is respectfully traversed.

Claims 1, 18 and 25 have been amended to more clearly state the type of electroactive polymer actuator recited.

Brown discloses anti-embolism stockings controlled by polymer gel strips which constrict upon electrical stimulation, thereby causing compression to be exerted upon a portion of the body. See col. 4, lines 26-52, claim 1 and claim 9. The actuator required by the instant claims, however, is nowhere disclosed in the Brown patent. Brown is also silent with regard to the ability of the disclosed stockings to function in synchrony with the heartbeat of the user.

For a reference to anticipate a claim it must disclose each an every element of the claim. See MPEP 2131 and cases cited therein, especially Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989) and In re Marshall, 578 F.2d 301, 304, 198 U.S.P.Q. 344, 346 (Fed. Cir. 1978).

Because the Brown reference fails to disclose each and every element of the present claims, it fails as an anticipation under 35 U.S.C. 102. Thus, it is respectfully requested that this rejection be reconsidered and withdrawn.

Rejection under 35 U.S.C. 103 over Brown

Claims 2-4, 22 and 23 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Brown. This rejection is respectfully traversed.

In view of the limitations of the instant claims not disclosed by Brown as discussed above, no method of incorporation of the electroactive polymer actuators would result in the invention claimed. Thus the instant claims are not obvious from the teachings of Brown within the meaning of 35 U.S.C. 103, and it is respectfully requested that this rejection be reconsidered and withdrawn.

Rejection under 35 U.S.C. 103 over Brown and Shabty

Claims 8-14, and 26-29 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Brown in view of Shabty et al. US 2005/0137507 (Shabty). This rejection is respectfully traversed.

The crux of the Shabty disclosure is a cuff or plurality of cuffs for counterpulsation therapy without the use of compressed air. The cuffs are not, however, of the type required by the instant claims, and they are not controlled by electroactive polymers.

Because the cuffs are not controlled by electroactive polymer actuators, the proper combinability of the two references is highly questionable. That is, no suggestion and motivation to combine the references can be found within them. *In re Jones*, 958 F.2d 347, 351, 21 U.S.P.Q.2d 1941, 1943-44 (Fed. Cir. 1992), *In re Fine*, 837 F.2d 1071, 1075, 5 U.S.P.Q. 1596, 1598-99 (Fed. Cir. 1988). Combination of various selected pieces of the reference teachings without such suggestion/motivation can be based only on undue hindsight. See MPEP 2142 , second paragraph. See also *Akzo N.V. v. U.S. International Trade Commission*, 808 F.2d 1241, 1480-81, 1 U.S.P.Q.2d, 1241, 1246 (Fed. Cir. 1986), *cert. denied,* 482 U.S. 909 (1987), *Loctite Corp. v. Ultraseal Ltd.*, 781 F.2d 861, 874, 228 U.S.P.Q. 90-99 (Fed. Cir. 1985).

Furthermore, even if the reference teachings were combined, the invention of the instant claims would not result in the here claimed invention, for example, due to the deficiencies discussed above in conjunction with Brown. Thus, it is respectfully requested that this rejection be reconsidered and withdrawn.

Provision rejections under the judicial construction of obviousness type double patenting— U.S. Application Serial No. 10/373,940

The outstanding *provisional* rejection of various claims under the judicial construction of obviousness type double patenting over claims in U.S. Application Serial No. 10/373,940 is acknowledged. As noted in MPEP 804 I B (emphasis added):

> Occasionally, the examiner becomes aware of two copending applications >that were< filed by the same inventive entity, or by different inventive entities having a common inventor, and/or by a common assignee >, or that claim an invention resulting from activities undertaken within the scope of a joint research agreement as defined in 35 U.S.C. 103(c)(2) and (3),< that would raise an issue of double patenting ***if one of the applications became a patent***. ... The merits of such a provisional rejection ***can*** be addressed by both the applicant and the examiner without waiting for the first patent to issue.

Applicant will accordingly address the provisional rejection if and when the issue ultimately matures.

Conclusion

In light of the above remarks, applicant believes that all of the rejections of record have been obviated, and allowance of this application is respectfully requested.

Fees

The Examiner is authorized to any fees that may be due to the undersigned attorney's PTO Deposit Account #50-1047.

Serial No. 10/645,814

Respectfully submitted,

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I hereby certify that this document and any document referenced herein is being sent to the United States Patent and Trademark office via Facsimile to: 571-273-8300 on May 17, 2006.

David B. Bonham
(Printed Name of Person Mailing Correspondence)

(Signature)